



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,978	08/19/2003	Robert A. Dunstan	42P17260	6363

8791 7590 03/16/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

BUTLER, DENNIS

ART UNIT PAPER NUMBER

2115

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,978

Applicant(s)

DUNSTAN ET AL.

Examiner

Dennis M. Butler

Art Unit

2115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/2/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 2115

1. This action is in response to the application filed on August 19, 2003. Claims 1-47 are pending.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 and 29-47 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "the computing device" lacks proper antecedent basis because the preceding phrase recites a data processing device.

Claims 2-16 are rejected because they incorporate the deficiencies of claim 1.

Regarding claim 16, the phrase "the audio controller" lacks proper antecedent basis.

Regarding claim 29, the claim is indefinite because it does not end in a period and it is unclear whether it is complete.

Claims 30-31 are rejected because they incorporate the deficiencies of claim 29.

Regarding claim 32, the phrase "the computing device" lacks proper antecedent basis because the preceding phrase recites a data processing device.

Claims 33-47 are rejected because they incorporate the deficiencies of claim 32.

Regarding claim 47, the phrase "the audio controller" lacks proper antecedent basis.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 32-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a machine accessible medium containing instructions that cause functions to be performed at some future time when the instructions are executed. Applicant has defined the medium as a signal in paragraph 33 of the published application. Therefore, the claims are directed to an electro-magnetic signal, a carrier wave, electrical, optical and acoustical signals that are a form of energy. The claims recite a signal encoded with functional descriptive material. The signal is nonstatutory because it is a form of energy and it does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101 as disclosed in the statute in paragraph 4 above.

Art Unit: 2115

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2115

10. Claims 1, 6-8, 17-18, 21, 23-25, 32 and 37-39 rejected under 35 U.S.C. 102(b) and/or 102(a) as being anticipated by Microsoft, OnNow Power Management.

Per claims 1 and 32:

A) Microsoft teaches the following claimed items:

1. configuring a data processing device to recognize a visual on state and a visual off state with the operating system determining and controlling the power states in the Overview of the OnNow Architecture section and with figure 1;
2. identifying a request to turn off the data processing device with the user pushing the front panel button in the Overview of OnNow Power States and Power Policy section.
3. transitioning the device to the visual off state with figure 2, in the Overview of OnNow Power States and Power Policy section and in the WM_POWERBROADCAST section on page 4.

Per claim 17:

A) Microsoft teaches the following claimed items:

1. a data processing device configured to recognize a visual on state and a visual off state with figure 1 and with the operating system determining and controlling the power states in the Overview of the OnNow Architecture section;
2. a human interface device coupled to the data processing device with the display device in figure 1, with the user interface and at the first paragraph of page 3;

Art Unit: 2115

3. a module capable of intercepting a request to turn off the data processing system and transition the data processing device to the visual off state with the operating system module, with figure 2, in the Overview of OnNow Power States and Power Policy section and in the WM_POWERBROADCAST section on page 4.

Per claims 6-8, 18, 21, 23-25 and 37-39:

Microsoft describes generating a request to turn off the device by pressing a button on the device, automatically generating the request based on coupled devices and inactivity with the last paragraph on page 2 and with the WM_POWERBROADCAST section on page 4. Microsoft describes identifying a request to turn on the data processing device and transitioning to the visual on state with the wake-up request, with figure 2 and with the Overview of OnNow Power States and Power Policy section.

11. Claims 2-5, 9-16, 19-20, 22, 26-31, 33-36 and 40-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft, OnNow Power Management.

Per claims 2-5, 9-16, 19-20, 22, 26-31, 33-36 and 40-47:

Microsoft teaches the claimed items as described above. The claims differ from Microsoft, OnNow Power Management in that Microsoft, OnNow Power Management fails to explicitly teach the elements recited in Claims 2-5, 9-16, 19-20, 22, 26-31, 33-36 and 40-47. Regarding claims 2, 5, 19, 22, 33 and 36, Microsoft does not explicitly describe turning audible and visual indicators on and off as claimed. However, Microsoft describes transitioning the device between

the sleep state (visual off) and the working state (visual on) with figure 2.

Microsoft describes that the sleep state is the default low power state and in the sleep state, the processor is not executing code and no work is being accomplished for the user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to turn off audible and visual indicators in the visual off (sleep) state and turn on audible and visual indicators in the visual on (working) state in order to save power in the visual off state and perform audible and visual work in the visual on state. In addition, turning audible and visual indicators on and off as claimed would intensify the perception that the device is in an on or off state. Regarding claims 4 and 35, Microsoft describes identifying a request to turn on the data processing device and transitioning to the visual on state with the wake-up request, with figure 2 and with the Overview of OnNow Power States and Power Policy section. Regarding claims 3, 20 and 34, Microsoft describes that the operating system is in control of power state transitions. Microsoft further describes providing API extensions that provide for communication between the operating system and applications. Microsoft also describes interfacing the OnNow system with the ACPI specification. It would have been obvious to one having ordinary skill in the art at the time the invention was made to intercept a turn off request prior to receipt by the operating system in order to route requests such as legacy requests to the BIOS to the operating system. Microsoft describes a human interface device coupled to the data processing device with the display device in figure 1, with the user interface and

Art Unit: 2115

at the first paragraph of page 3. Microsoft describes that the visual off state is the low power sleep state that turns off the processor at page 2 in the Overview of OnNow Power States and Power Policy section. Regarding claims 12-16, 28-31 and 43-47, Microsoft describes that the OnNow system achieves a vision of the always-on PC that can quickly resume processing. Microsoft describes auto-saving files and device states when the system is going to sleep. It would have been obvious to one having ordinary skill in the art at the time the invention was made to intercept messages from the operating system to a graphics or audio controller and store the messages to memory in order to resume processing quickly with the audio and graphics controllers in the proper state to resume processing.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis M. Butler whose telephone number is 571-272-3663. The fax number for this unit is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/644,978

Page 9

Art Unit: 2115

Dennis M. Butler

Dennis M. Butler
Primary Examiner
Art Unit 2115